BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

In re Application of: Cynthia Cassel Robert Cassel Jr.	Date:	March 16, 2006
Serial No.: 09/767,413	Group Art Unit:	2632
Filed: 01/23/01	Examiner:	Toan Pham
Title: Combination Breathing Monitor Alarm and Audio Baby Alarm		

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313.

Terry Lakos — 3/17/06

Name: TERRY LAKOS — Date

REPLY TO EXAMINER'S ANSWER

Hon. Commissioner of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313

Dear Sir:

This is a reply to the Examiner's Answer dated 02/13/2006 for the appeal associated with the above identified application.

Applicant would like to reiterate his position that the Examiner failed to provide evidence that makes a prima facie showing of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the

applicant's invention itself. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994).

When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. In re Ichihashi, Civ. App. No. 93-1172, slip op. at 2-3 (Fed. Cir. Sep. 9, 1993) (unpublished)

In the absence of some evidence of the level of ordinary skill, including evidence tending to show what one of such ordinary skill would be motivated to accomplish in view of the cited prior art, the board may not rest a prima facie case only on its own unsupported assertions. Swede Industries v. Zebco Corp., Civ. App. No. 93-1403, slip op. at 4-5 (Fed. Cir. April 12, 1994) (unpublished)

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. Additionally, there is no indication as to the motivation for combining those known element that may appear in the present invention to pliable chest straps, soft and formable materials, resonant sensors, microphones, and recievers as disclosed in the present invention.

It is well settled that in order to establish a *prima facie* case of obviousness under 103(a), the examiner must show that some OBECTIVE teaching, suggestion or motivation in the applied art taken as a whole. The examiner assumes first that the cited references would lead a user to want to provide a plurality of signal lights affixed to said pair of mounting arms and supported from a mud flap bracket assembly, and then given such, concludes that the reference would make it obvious to provide such a combination as is

presented herein. However, there is lack of evidence to prove that, at the relevant time, a person would be motivated to make the proposed combination without recourse to the teachings in the present invention. See generally, In re Rouffet, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); Pro-Mold and Tool Co v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996). This also extends to the determination of whether the references can be combined. See In Rre Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

In the present case, the examiner is, in essence , reading backwards from the result proposed in the present application and citing three references in a way that does not flow logically to the conclusion that the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 f.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

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